

Appl. No. 10/636,171
Amdt. dated July 27, 2005
Reply to Office action of May 25, 2005

REMARKS/ARGUMENTS

Applicants have received the Office action dated May 25, 2005, (hereinafter "*Office Action*"), in which the Examiner: 1) objected to claims 7, 13-15, 17, 18, and 20-22 because of various informalities; 2) rejected claims 1-11 under 35 U.S.C. § 112, second paragraph, as allegedly indefinite; 3) rejected claims 1-5, 7, 8, 10, 12-15, 17-20 and 22 under 35 U.S.C. § 102(b) as allegedly anticipated by *Corrington et al.* (U.S. Pat. No. 6,076,142); 4) rejected claims 6, 9 and 16 under 35 U.S.C. § 103(a) as allegedly unpatentable over *Corrington* and further in view of *Berglund et al.* (U.S. Pat. No. 6,199,130); and 5) rejected claim 11 under 35 U.S.C. § 103(a) as allegedly unpatentable over *Corrington* and further in view of *Garnett et al.* (U.S. Pat. No. 6,869,314).

With this Response, Applicants have amended claims 1, 7, 12-15, and 17-22, and canceled claims 6 and 16. Therefore, claims 1-5, 7-15, and 17-22 remain pending.

I. CLAIM 21

As best as Applicants can tell, the status of claim 21 is indeterminate. Although the *Office Action Summary* notes that claim 21 is rejected, there does not appear to be any mention of claim 21 in the *Detailed Action* portion of the *Office Action*. Applicants have rewritten claim 21 in independent form and respectfully submit that this amendment should not be interpreted as a concession by Applicants that claim 21 in its dependent form was unpatentable over the cited art. Rather, Applicants merely amended independent claim 21 in an effort to narrow the issues before the Examiner.

II. CLAIM OBJECTIONS

Applicants appreciate the Examiner's thorough review of the application including calling Applicants' attention to various informalities of claims 7, 13-15, 17, 18, and 20-22. Applicants have amended claims 7, 13-15, 17, 18, and 20-22 to correct any informalities that may have existed in the claims, and respectfully submit that these amendments are clerical in nature and therefore these amendments should not be interpreted as limiting the scope of the claim or its equivalents.

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III. REJECTIONS UNDER § 112

Claims 1-11 stand rejected under 35 U.S.C. § 112, 2nd paragraph because the phrase "the status of the storage device" allegedly lacks antecedent basis. Applicants respectfully traverse because inherent components of recited claim elements have antecedent basis in the recitation of the elements themselves. MPEP § 2173.05(e); see also, *Bose Corp. v. JBL, Inc.*, 274 F.3d 1354, 1359 (Fed. Cir 2001) (finding that recitation of the claim element "an ellipse" provided antecedent basis for the phrase "an ellipse having a major diameter" because "[t]here can be no dispute that mathematically[,] an inherent characteristic of an ellipse is a major diameter"). Likewise, since "status" is an innate characteristic of storage devices, recitation of a storage device itself provides sufficient antecedent basis for the phrase "the status of the storage device". Accordingly, Applicants respectfully request reconsideration.

IV. COMBINING CORRINGTON WITH BERGLUND RENDERS CORRINGTON UNSATISFACTORY FOR ITS INTENDED PURPOSE

As the Examiner is undoubtedly aware, a *prima facie* case of obviousness requires that there be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. MPEP § 2143. Further, there is no suggestion or motivation to make a proposed modification if a proposed modification would render the prior art invention that is to be modified unsatisfactory for its intended purpose. *In re Gordon*, 733 F.2d 900 (Fed. Cir. 1984).

The Examiner rejected the pending claims as allegedly obvious under § 103 over *Corrington* in view of *Berglund*.¹ Independent claim 1, as amended, requires, "a backplane controller coupled via a secondary bus to the storage controller ... wherein the secondary bus is an I²C bus." The Examiner contends that Fig. 26 of *Corrington* teaches a backplane controller in ICU 22/processor 260

¹ Since Applicants have amended the elements of claims 6 and 16 into the independent claims 1, 12, and 19, the Examiner's initial obviousness rejection of claims 6 and 9 is, effectively, an obviousness rejection of the pending claims.

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and a secondary bus in Ethernet connections 266, or alternatively, in analog-to-digital converter 286. *Office Action* at 5 (referring to claim 7). Further, the Examiner asserts that one of ordinary skill in the art would have been motivated to replace either Ethernet connection 266 or analog-to-digital converter 286 with the I²C bus disclosed in *Berglund*. *Office Action* at 10-11 (referring to claims 6 and 9). Applicants respectfully traverse.

Ethernet connection 266 and analog-to-digital converter 286 are electrical components not busses. A bus is a signal line or set of lines used by an interface system to connect a number of devices and to transfer data. THE IEEE STANDARD DICTIONARY OF ELECTRICAL AND ELECTRONICS TERMS 117 (6th ed. 1996). As suggested by the Examiner, the Ethernet connection 266 may be represented by the ML6692 manufactured by Micro Linear, which "implements the complete physical layer of the Fast Ethernet 100BASE-TX standard." *ML6692 Specification Sheet* at 1. Some of the functions of the ML6692 include auto-negotiation, 4B/5B encoding and decoding, Stream Cipher scrambling and descrambling, and 125 MHz clock recovery and generation. *Id.* Since an I²C bus performs none of these functions, one of ordinary skill in the art would not be motivated to replace the Ethernet connection 266 with an I²C bus because to do so would severely limit communication abilities between the ICU 260 and the RAID controller. Additionally, even in "fast mode," an I²C bus operates at a maximum of 3.4 Mbps, not the 100 Mbps recited in the *ML6692 Specification*, and therefore one of ordinary skill in the art would not have been motivated to replace the ML6692 with an I²C bus for at least this additional reason.

Furthermore, as suggested by the Examiner, the analog-to-digital converter 286 may be represented by the ML2258 manufactured by Micro Linear, which provides "an 8-bit A/D converter, 8-channel analog multiplexer, and a microprocessor compatible 8-bit parallel interface." *ML2258 Specification Sheet* at 1. An I²C bus is not capable of converting analog measurements into digital values or capable of performing any of the other functions performed by the ML2258. Thus, one of ordinary skill in the art would not be motivated to replace the ML2258 with an I²C bus because an I²C bus is not capable of performing the

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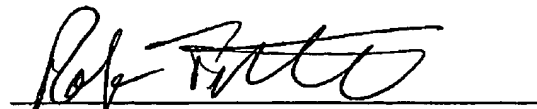
analog-to-digital conversion that is required of block 286. For at least this additional reason the Examiner has failed to establish a *prima facie* case of obviousness with regard to the pending claims.

V. CONCLUSION

In the course of the foregoing discussions, Applicants may have at times referred to claim elements in shorthand fashion, or may have focused on a particular claim element. This discussion should not be interpreted to mean that the other elements can be ignored or dismissed. The claims must be viewed as a whole, and each element of the claims must be considered when determining the patentability of the claims.

Applicants respectfully request reconsideration and that a timely Notice of Allowance be issued in this case. It is believed that no extensions of time or fees are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required (including fees for net addition of claims) are hereby authorized to be charged to Hewlett-Packard Development Company's Deposit Account No. 08-2025.

Respectfully submitted,



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